

REMARKS

Applicants have canceled claims 3, 51 and 63-65 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application.

Claim 1 is amended to recite "wherein said compound is at least 95% complementary with SEQ ID NO: 4," claim 13 is amended to recite "comprising 100% complementarity with SEQ ID NO: 4," and claim 61 is amended to recite "wherein said compound is at least 90% complementary with SEQ ID NO: 4." Support for these amendments can be found, for example, at page 17, lines 12-24. Claim 5 is amended to recite "in which the oligonucleotide is a single-stranded oligonucleotide." Support for this amendment can be found, for example, at page 18, line 17. Claim 20 is amended to recite "modified nucleobase." Support for this amendment can be found, for example, at page 38, line 7 through page 40, line 2. Claim 46 is amended to recite "an antisense oligonucleotide comprising the nucleobase sequence of SEQ ID NO: 19," to clarify the claim language. Claims 58 and 59 are amended to depend from claim 50, and claim 66 is amended to depend from claim 59.

Applicants have added new claims 69-73. Support for these claims can be found throughout the application as filed, and therefore no new matter is added. Support for new claims 69-70 can be found, for example, in Example 15, starting on page 79. Support for new claim 71-72 can be found, for example, at page 43, line 27 through page 44, line 3. Support for new claim 73 can be found, for example, at page 42, line 1 through page 43, line 9, and Example 15, starting on page 79.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present

Application No.: 10/789,526
Filing Date.: February 26, 2004

disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Patents/Applications of Assignee

Applicants wish to draw the Examiner's attention to the following patents/applications assigned to the assignee of the present application.

Serial Number	Title	Filed
10/927,466	MODULATION OF GROWTH HORMONE RECEPTOR EXPRESSION AND INSULIN-LIKE GROWTH FACTOR EXPRESSION	08/25/2004

Provisional Obviousness-type Double Patenting

Claims 1, 3-6, 13, 20-23, 46-47, 50-68 are provisionally rejected on the ground of non-statutory obviousness-type double patenting over claims 1-15 and 17-23 of copending Application No. 10/927,466.

In light of the arguments and amendments presented herein, Applicants respectfully submit that the provisional obviousness-type double patenting rejections over copending Application Serial No. 10/927,466 is the sole remaining rejections in the instant application. M.P.E.P. § 804 provides in relevant part:

If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw the rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. *M.P.E.P. § 804(I)(B)*.

Consistent with M.P.E.P. § 804, Applicants respectfully request that the remaining provisional double patenting rejection be withdrawn and the instant Application be allowed to issue. In addition, Applicants note that claims 1-23 of copending Application No. 10/927,466 have been canceled, and therefore there is currently no basis for the rejection. In the event that double patenting issues remain during the prosecution of the 10/927,466 application, Applicants will consider filing an appropriate terminal disclaimer.

Claim Objection

The Examiner objects to claim 58 as being a substantial duplicate of claim 13. Claim 58 has been amended to depend from claim 50, rather than claim 1, and therefore the claim scope of claims 13 and 58 are not substantially duplicative. Applicants therefore request withdrawal of this objection.

35 U.S.C. § 102(b) – Olek et al.

Claims 1, 4-6, 20 and 63 are rejected as anticipated by SEQ ID NO: 257516 of Olek *et al.* The Examiner asserts that Olek *et al.* discloses a 13 base nucleotide sequence, a 12 consecutive nucleotide portion of which is identical to SEQ ID NO: 19 of the instant application.

Claim 1 recites “A compound from 12 to 50 nucleobases in length targeted to a nucleic acid molecule encoding growth hormone receptor, wherein said compound comprises an at least 8 consecutive nucleobase portion of SEQ ID NO: 19; and wherein said compound is at least 95% complementary with SEQ ID NO: 4 as measured over the entirety of said compound.” According to the Examiner, a compound of SEQ ID NO: 257516 of Olek *et al.* would have 12 of 13 bases, or 92%, complementary with SEQ ID NO: 4. Therefore, SEQ ID NO: 257516 of Olek *et al.* does not anticipate claim 1, or any claims that depend therefrom. Claim 63 has been canceled, rendering the rejection of claim 63 moot. In view of the above, Applicants request reconsideration and withdrawal of the anticipation rejection of the claims.

35 U.S.C. § 102(b) – Roberts et al.

Claim 63 is rejected as anticipated by SEQ ID NO: 630 of Roberts *et al.* The Examiner asserts that Roberts discloses a 10 base nucleotide sequence that is 100% complementary to SEQ ID NO: 4 of the instant application.

Claim 63 has been canceled, rendering the rejection of claim 63 moot.

35 U.S.C. § 103(a) – Olek et al. in view of Bennett et al.

Claims 1 and 20-23 are rejected as unpatentable over Olek *et al.* in view of Bennett *et al.* The Examiner asserts that Olek discloses a 13 base nucleotide sequence, a 12 consecutive

Application No.: 10/789,526
Filing Date.: February 26, 2004

nucleotide portion of which is identical to SEQ ID NO: 19 of the instant application, but does not teach the recited internucleoside, nucleobase or sugar modifications.

Claim 1 recites “A compound from 12 to 50 nucleobases in length targeted to a nucleic acid molecule encoding growth hormone receptor, wherein said compound comprises an at least 8 consecutive nucleobase portion of SEQ ID NO: 19; and wherein said compound is at least 95% complementary with SEQ ID NO: 4 as measured over the entirety of said compound.” According to the Examiner, a compound of SEQ ID NO: 257516 of Oleck *et al.* would have 12 of 13 bases, or 92%, complementary with SEQ ID NO: 4. Therefore, SEQ ID NO: 257516 of Oleck *et al.* does not render obvious claim 1, or any claims that depend therefrom. Bennett *et al.* does not overcome this deficiency in Olek *et al.* In view of the above, Applicants request reconsideration and withdrawal of the obviousness rejection of the claims.

35 U.S.C. § 112 – Indefiniteness

The Examiner rejects claims 46-47, 60 and 64-68 as indefinite for reciting “an antisense oligonucleotide comprising a nucleobase sequence of SEQ ID NO: 19.” The Examiner asserts that the scope of this claim is vague and indefinite.

Applicants have amended claim 46 to recite “an antisense oligonucleotide comprising the nucleobase sequence of SEQ ID NO: 19.” Applicants therefore respectfully request withdrawal of the rejection of the indefiniteness rejection of the claims.

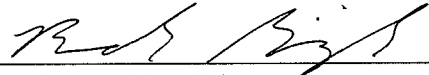
Application No.: 10/789,526
Filing Date.: February 26, 2004

Applicants submit that the present application is in condition for allowance and respectfully requests an action to that effect. If any issues remain, the Examiner is invited to contact Applicants' counsel at the number provided below in order to resolve such issues promptly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9/27/07

By: 
Brenden S. Gingrich
Registration No. 60,295
Attorney of Record
Customer No. 55389
(619) 235-8550

4300517
092107